

REMARKS

The Office Action rejects claims 65, 66, and 68-75 under 35 U.S.C. § 112, first paragraph. Office Action at p. 2. Additionally, the Office Action rejects claims 65-74 under 35 U.S.C. § 112, second paragraph, as being indefinite. Id. at p. 3. The Office Action also rejects claims 38-51, 53-58, 61, and 63-75 under 35 U.S.C. § 103(a) as being unpatentable over Armellin (U.S. Patent No. 6,244,315), Haas (U.S. Patent No. 4,606,389), "Japan 215 (JP 183215)," "Japan 218 (JP 11-208218)," "Japan 907 (JP 63-116907)," and "Germany 624 (DE 3901624)." Id. at 4. The Office Action also rejects claims 45-47, 58-60, and 62-63 under 35 U.S.C. § 103(a) as being unpatentable over the preceding references "and further in view of Nakagawa et al. (US 6220320) or Japan 307 (JP 63-315307)." Id. at 9.

By this Reply, Applicant has amended independent claim 65 to recite "providing the pair of motorcycle tires on the motorcycle, the pair of motorcycle tires comprising: a front motorcycle tire; and a rear motorcycle tire." Additionally, Applicant has amended independent claim 65 to recite "providing a central zone of the tread band of the front motorcycle tire with a sea/land ratio of about 15% to about 30% to promote water-draining capacity of the front motorcycle tire under a ground contacting area within a central zone of the tread band of the front motorcycle tire; and providing a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire to promote traction capacity of the rear motorcycle tire." Further, Applicant has amended claim 75 to recite "axially opposite intermediate side zones lying between the central zone and the shoulder zones, wherein each of the intermediate side zones has a sea/land ratio of about 10% to about 30%." Applicant respectfully submits that the

originally filed application and drawings fully support the claim amendments. No new matter has been added. Claims 38-51 and 53-75 are currently pending in this application.

Rejection Under 35 U.S.C. § 112, First Paragraph

While Applicant respectfully submits that the originally filed application and drawings fully supported the previous wording of claims 65, 66, and 68-75, the amendments to claim 65 and 75 should remove the Examiner's concerns about claims 65, 66, and 68-75 under § 112, first paragraph. Accordingly, Applicant respectfully requests withdrawal of the rejection of these claims under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Regarding the rejections of claims 65-74 under 35 U.S.C. § 112, second paragraph, Applicant respectfully submits that the Amendments to claim 65 should address the Examiner's concerns expressed in the Office Action. While Applicant respectfully submits that the previous wording of claims 65-74 fully complied with the requirements of Section 112, Applicant respectfully submits that the amendments to claim 65 should remove the Examiner's concerns about "the scope and meaning" of these claims. See Office Action at 2. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 65-74 under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 103(a)

Regarding the rejections of claims 38-51 and 53-75 under 35 U.S.C. § 103(a), Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness. A proper obviousness rejection must address every claim feature.

See M.P.E.P. § 2143.03. To establish a *prima facie* case of obviousness, the Office Action must provide a clear explanation with rational underpinnings that demonstrates why a person of ordinary skill in the art would have found the claimed subject matter obvious. M.P.E.P. § 2142.

In a pair of motorcycle tires according to any of claims 38-51, 53-64, and 75, "at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within a central zone of the tread band of the front motorcycle tire" and "the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire." Similarly, a method according to any of claims 65-74 includes, *inter alia*, "providing a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire" and "providing a central zone of the tread band of the front motorcycle tire with a sea/land ratio of about 15% to about 30%."

None of the references cited in the Office Action teaches or suggests combining a rear motorcycle tire having a null sea/land ratio within a central zone of its tread band with a front motorcycle tire having circumferential groove or a sea/land ratio of about 15% to about 30%. In attempt to address this deficiency, the Office Action suggests that a person of ordinary skill in the art would find it obvious to randomly mix various types of front motorcycle tire tread patterns with various types of rear motorcycle tire tread patterns because "Armellin teaches that the front and rear tire of a motorcycle should be different." See Office Action at pp. 6-7. Contrary to the implication of this assertion, Armellin does not teach or suggest that the configuration of the central zone

of the tread band of a front motorcycle tire should differ from that of the rear tire, only that the curvature ratio of front and rear motorcycle tires should differ. Col. 8, ll. 24-34.

In attempt to cure this deficiency, the Office Action “optionally” cites German 624. Office Action at p. 6. Contrary to the assertion of the Office Action, a person of ordinary skill in the art would not look to German 624 in deciding the appropriate configuration of motorcycle tires because German 624 discusses only tires used on four-wheeled vehicles. A person of ordinary skill in the art would understand that dramatically different handling characteristics of motorcycles and four-wheeled vehicles create significantly different design considerations for motorcycle tires. Accordingly, German 624 constitutes non-analogous art and cannot support a *prima facie* case of obviousness. See M.P.E.P. § 2141.01(a)l.

Additionally, Applicant respectfully submits that German 624 teaches away from the claimed invention. German 624 states that “[a]nother advantage stems from the fact that the tread profile of the rear tire is formed from one or several main circumferential grooves extending continuously in the circumferential direction of the tire in the middle segment of the tread strip.” English Translation of German 624 at pp. 4 and 5.

Applicant respectfully submits that this would discourage a person of ordinary skill in the art from implementing the features of claims 38-51, 53-64, and 75 that “the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire,” as well as the features of claim 65-74 of “providing a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire.” German 624 would discourage a person of ordinary skill in the art from implementing the claimed “substantially null

sea/land ratio within a central zone of the tread band of the rear motorcycle tire”
because German 624 would lead a person of ordinary skill in the art that this claimed construction would not enjoy the advantages of having one or several main circumferential grooves in the middle portion of the rear tire.

Because it would discourage a person of ordinary skill in the art from implementing the claimed invention, German 624 teaches away from a claimed invention. Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). A reference that teaches away from a claimed combination generally cannot support a *prima facie* case of obviousness of that claimed combination. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Thus, the Office Action presents no tenable explanation of why a person of ordinary skill in the art would have actually found it obvious to combine no less than eight references in just the right way to arrive at Applicant’s invention.¹ Such use of Applicant’s disclosure “as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of [Applicant’s claimed invention]” constitutes improper hindsight reconstruction. Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907 (Fed. Cir. 1988), citing Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012 (Fed. Cir. 1983).

¹ Applicant does not concede that the suggested combination of references includes all of the features recited in Applicant’s claims.

Thus, the Office Action does not establish a *prima facie* case of obviousness of claims 38-51 and 53-75. Accordingly, Applicant respectfully requests withdrawal of the rejections of these claims under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned agent at 202-408-4492.

Respectfully submitted,

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By: 

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